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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,129	06/24/2003	Paul E. Jacobs	030408	4024
23696	7590	10/27/2005	EXAMINER	
QUALCOMM, INC 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			TAN, ALVIN H	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,129

Applicant(s)

JACOBS ET AL.

Examiner

Alvin H. Tan

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. Claims 1-52 have been examined and rejected. This is the first Office action on the merits.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) for the following reasons:
 - a. Reference characters "102", "202", "402", and "502" have all been used to designate the e-mail document.
 - b. Reference characters "104", "204", "304", "404", and "504" have all been used to designate the e-mail.
 - c. Reference characters "106", "206", "306", "406", and "506" have all been used to designate the mailbox tree.
 - d. Reference characters "108", "208", "308", and "508" have all been used to designate the mailbox folder "Spamwatch".
 - e. Reference characters "110" and "210" have all been used to designate the highlighted word "Spamwatch".
 - f. Reference characters "112", "314", and "514" have all been used to designate the same window.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "602" mentioned on *[page 4, line 22]*.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "202" "306", "502", and "506".

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:

- a. On [page 3, line 21], Examiner suggests eliminating the comma before
“The content of...”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42, and 44-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Hung (Pub No. US 2002/0087584).

Claims 1-3, 5-7 (Method)

Claims 14-16, 18-20 (Computer Readable Medium)

Claims 27-29, 31-33 (Apparatus)

Claims 40-42, 44-46

- 8-1. Regarding claims 1, 14, 27, and 40, Hung teaches a method and system for organizing messages that arrive at a communication terminal or other machine. Hung teaches the claim of a method for transferring a document into a folder comprising

identifying a portion of a document and transferring the document into a folder associated with the identified portion, by disclosing that upon the receipt of a message, the communication terminal may present a received-message to a user and may prompt the user to select an expression from the received-message, to be used to identify a new folder, such as an expression from the body of the message. A new folder may be created to store messages that match the expression selected by the user and may store the message and other matching messages in the folder *[paragraph 6]*.

Hung teaches the invention on an exemplary machine shown in *[figure 2; paragraph 19]*.

8-2. Regarding claims 2, 15, 28, and 41, Hung teaches the claim of the method wherein said identifying includes selecting a word within the document, by disclosing that the user can select a value from a text message *[paragraph 42]*.

8-3. Regarding claims 3, 16, 29, and 42, Hung teaches that the user can select at least one value from a text message *[column 42]*. The value may be a word, which is made up of several symbols. Thus, the invention is capable of selecting a symbol within the document if it selects a single letter word.

8-4. Regarding claims 5, 18, 31, and 44, Hung teaches the claim of the method wherein said identifying includes speaking the portion, by disclosing that input means includes a microphone *[paragraph 19, lines 11-15]*.

8-5. Regarding claims 6, 19, 32, and 45, Hung teaches the claim of the method wherein said identifying includes touching the portion, by disclosing that input means includes a touch sensitive display *[paragraph 19, lines 11-15]*.

8-6. Regarding claims 7, 20, 33, and 46, Hung teaches the claim of the method wherein the folder includes a pre-established folder, by disclosing that if the message satisfies an existing message-filter expression, the message may be stored in that folder *[paragraph 74]*.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 17, 30, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (Pub No. US 2002/0087584) and Clark et al (US Patent No 6,725,228),.

Claims 4 (Method)

Claims 17 (Computer Readable Medium)

Claims 30 (Apparatus)

Claims 43

10-1. Regarding claims 4, 17, 30, and 43, Hung teaches the invention substantially as claimed. See section 8-1. Hung further teaches that words may be presented to the user, in which case, the user selects the word *[paragraph 43]*. The communication terminal may be a notebook computer *[paragraph 16]*. Hung does not expressly teach the claim of the method wherein said identifying includes clicking on the portion. Clark teaches a similar invention that organizes messages into multiple folders based on the contents and attributes of the message *[column 4, lines 26-39]*. Clark teaches that a message client provides a user interface on a laptop computer *[column 12, lines 7-10]* and receives user input from the interface using an input device such as a mouse *[column 9, lines 30-35]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system of organizing messages of Hung, the use of a mouse as an input device, as taught by Clark. The use of a mouse as an input device provides a more flexible input device for inputting commands. This would allow a user to select the word by clicking on it.

11. Claims 8-9, 21-22, 34-35, and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (Pub No. US 2002/0087584) and Internet Explorer 5, as taught by Freeze (1999).

Claims 8-9 (Method)

Claims 21-22 (Computer Readable Medium)

Claims 34-35 (Apparatus)

Claims 47-48

11-1. Regarding claims 8, 21, 34, and 47, Hung teaches the invention substantially as claimed. See section 8-1. Hung does not expressly teach further indicating that the document is being transferred into the folder. Freeze teaches that Internet Explorer shows a download status screen when a document is being transferred to a computer *[page 392]*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, the use of a status screen to show the transfer of a document to a folder, as taught by Freeze. This would alert the user that a document is being transferred.

11-2. Regarding claims 9, 22, 35, and 48, Hung teaches the invention substantially as claimed. See section 8-1. Hung does not expressly teach the claim of the method further indicating that the document has been transferred to the second folder. Freeze teaches that Internet Explorer displays a message indicating that the transfer of a document to a folder has been completed *[page 393]*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, the use of message window to indicate that the transfer of a document to a folder has been completed, as taught by Freeze. This would alert the user that a document has been transferred.

12. Claims 10-13, 23-26, 36-39, and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (Pub No. US 2002/0087584), Clark et al (US Patent No 6,725,228), and Internet Explorer 5, as taught by Freeze (1999).

Claim 10-13 (Method)

Claim 23-26 (Computer Readable Medium)

Claim 36-39 (Apparatus)

Claim 49-52

12-1. Regarding claims 10, 23, 36, and 49, Hung teaches the invention substantially as claimed. See section 8-1. Hung does not expressly teach transferring the document into a second folder associated with a second identified portion. Clark teaches a similar invention that organizes messages into multiple folders based on the contents and attributes of the message [*column 4, lines 26-39*]. Clark's invention improves upon prior art by teaching that in the prior art, filtering rules cannot organize a message into multiple folders without creating multiple copies of the message [*column 2, lines 28-32*]. Thus, Clark teaches that the ability to organize a message into multiple folders using filtering rules is well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, transferring messages into multiple folders, as taught by Clark. This would give the user

more flexibility when organizing messages since the user would not be restricted to a single folder.

Hung does not expressly teach further indicating that the document is being transferred into the second folder. Freeze teaches that Internet Explorer shows a download status screen when a document is being transferred to a computer [page 392]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, the use of a status screen to show the transfer of a document to a folder, as taught by Freeze. This would alert the user that a document is being transferred.

12-2. Regarding claims 11, 24, 37, and 50, Hung teaches the invention substantially as claimed. See section 8-1. Hung does not expressly teach transferring the document into a second folder associated with a second identified portion. Clark teaches a similar invention that organizes messages into multiple folders based on the contents and attributes of the message [column 4, lines 26-39]. Clark's invention improves upon prior art by teaching that in the prior art, filtering rules cannot organize a message into multiple folders without creating multiple copies of the message [column 2, lines 28-32]. Thus, Clark teaches that the ability to organize a message into multiple folders using filtering rules is well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, transferring messages into multiple folders, as taught by Clark. This would give the user

more flexibility when organizing messages since the user would not be restricted to a single folder.

Hung does not expressly teach the claim of the method further indicating that the document has been transferred to the second folder. Freeze teaches that Internet Explorer displays a message indicating that the transfer of a document to a folder has been completed *[page 393]*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, the use of message window to indicate that the transfer of a document to a folder has been completed, as taught by Freeze. This would alert the user that a document has been transferred.

12-3. Regarding claims 12-13, 25-26, 38-39, and 51-52, Hung, Clark, and Freeze teach the invention substantially as claimed. See section 12-2. Hung further teaches that the message may be stored in a pre-established folder or a newly created folder *[paragraph 74]*.

Conclusion

13. The prior art made of record on attached form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R § 111(c) to consider these references fully when responding to this action. The documents cited therein teach similar systems for transferring a document into a folder.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin H. Tan whose telephone number is 571-272-8595. The examiner can normally be reached on 8:30am-4:30pm, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on 571-272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHT
Assistant Examiner
Art Unit 2173

A handwritten signature in black ink, appearing to read 'Alvin H. Tan', is written over a horizontal line.